

Remarks

The above Amendments and these Remarks are in reply to the Office Action mailed March 19, 2003.

Claims 1-28 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected Claims 1-28. The present Response cancels Claims 5 and 24, amends Claims 1-2, 7-9, 14-15, 19, 21-23, 25-26 and 28. Reconsideration of the rejections is requested.

I. Summary of Examiner's Rejections

The drawings were objected to under MPEP §608.02(g).

The specification was objected to due to inconsistent terminology.

Claims 1-10, 15-16, 22-23, 25-26, and 28 were rejected under 35 U.S.C. §112, second paragraph as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicant regards as the invention.

Claims 1-28 were rejected under 35 U.S.C. §102(b) as being anticipated by *Weiser, et al.* (U.S. Patent No. 5,786,819).

Response to Rejections

The Examiner objects to the drawings stating that Figures 1 and 2 should be designated by the legend prior art. The Applicant respectfully disagrees. Many of the elements shown in Figure 1 and 2 are described in the specification as being configured to implemented to the system of the present invention and for that reason it would not be appropriate to label these figures as prior art.

The specification has been amended to avoid inconsistent terminology as objected to by the examiner.

Claims 1 -10, 15, 16, 22, 23, 25, 26, and 28 are objected to under 35 U.S.C. §112, second paragraph as being indefinite, for failing to particularly point out and distinctly claim the subject matter that the Applicant regards to the invention. The claims have been amended to avoid the indefinite rejections. For example, claim 1 has been amended to state that the "alphabetized" data list is separated into a plurality of sets. For this reason, there is considered to be an nexus between the steps of claim 2. Additionally, claim 1 is currently stated as a method for converting a list of data items into an abbreviated for transmission through a wireless network. The steps of the claims describe the way the abbreviated list is constructed, but does not necessarily describe how it is to be transmitted through the wireless network. Additionally, it is not true as suggested by the Examiner that all of the original data list needs to be transmitted. In some embodiments, it is possible that only the abbreviated list will be transmitted.

Claim 2 has been amended to correct the antecedent basis for the term “members.” Additionally, it is not considered that method of claims 1 and 2 generates a redundant abbreviated list, or no list at all depending on the claim language. The abbreviated list 104, shown in figure 4 is an example of a first abbreviated list. Each entry of abbreviated list 104 corresponds to at least one set. In the example of figure 4 one of the entries represents the sets corresponding to M, N and O. A second abbreviated list, in the Figure 4 example, list 108 can be constructed in which each entry in the second abbreviation list represents at least one set represented by an entry in the first abbreviated list. In the example of figure 4, one entry represents a set of the entry starting set of the data items starting with M, one entry represents the set of data starting with N and one entry represents the set of data starting with O. As the example of Figure 4 shows, it is believed that claim 2 is clear as written and does not need to be rewritten.

In claims 7, 9 and 28, have been objected to for lack clear and proper antecedent basis for term “the list.” These claims have been amended in order to avoid this antecedent basis problem.

Claims 15 and 26, have been objected due to the phrase “said first of said same first letters.” This phrase has been removed from these claims.

In claim 22, the term “the members” have been changed to “members” in order to provide proper antecedent basis.

Claim 23, has been amended to avoid the grammatical awkwardness.

Claim 25, has been amended to provide clean and proper antecedent basis for each of the terms in the claim.

For the above discussed reasons claims 1 - 10, 15, 16, 22, 23, 25, 26 and 28 are believed to avoid the 35 U.S.C. §112, second paragraph rejection.

Claims 1 - 28 are rejected under 35 U.S.C. § 102(b) as being clearly anticipated by Weiser, et al. U.S. Patent, 5,786,819. Weiser describes a system that allows for one button searching of a long list. As described in Weiser, the system switches between different modes while scrolling down through a list. In the first mode all of the data items in the list are displayed. Once the user has been scrolling for some time, the system switches into a mode which displays only the first data item for an initial letter. This allows the user to quickly scroll down to the correct letter. Once a correct letter is selected, the user can then scroll down through the list of data items for that letter. The switching between the different modes is time based rather than a function of the display screen.

Claim 1 of the present invention claims generating an abbreviated list having a maximum number of entries. Each entry is mapped to an control input in a display device. Weiser, et al. does not describe the system which each entry of abbreviated list is mapped to a control input and control display device. Weiser, describes a system with a scrolling display that uses a single button to switch between different modes, based upon how long the button has been pressed. Weiser does not however, describe any abbreviated list for which each entry is mapped to the control input display device.

For this reason claim 1 is believed to be allowable. Claims 2 - 4, 6 - 10 are dependent upon claim 1 and for that reason and because of the additional limitations of these claims, these claims are believed to be allowable.

Claim 11 includes the limitation of mapping sets to an input controller. This is not believed to be disclosed in the cited Weiser reference. For this reason claim 11 is believed to be allowable.

Claims 12 - 20 are dependent upon claim 11 are for that reason are believed to be allowable.

Claim 21 includes generating an abbreviated list of said common first characters, each entry in the abbreviated list being mapped to a control input and display device. For the reasons discussed above with respect to claim 1, this limitation is not disclosed or subjected in the cited references. For this reason 21 is believed to allowable. Claims 22 -23 and 25 - 28 are dependant upon claim 21 and for the additional limitations of the these claims are believed to be allowable.


The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

Date: 6/19/03

By: 
Joseph P. O'Malley
Reg. No. 36,226

FLIESLER DUBB MEYER & LOVEJOY LLP
Four Embarcadero Center, Fourth Floor
San Francisco, California 94111-4156
Telephone: (415) 362-3800